



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/758,067

01/14/2004

Jonathan J. Hull

015358-004031US

5097

20350 7590 07/24/2007

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

07/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,067

Applicant(s)

HULL ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 20-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peairs et al (US Patent No. 6,199,073)

Concerning claims 20, 25, Peairs et al discloses a system (Figs.2-3) for performing unconscious archiving of electronic documents in a network environment, wherein electronic documents are transferred over a network coupling at least one client computer (processing device) and at least one document management workstation (Fig.3) having at least one database (340) disposed to receive electronic copies of said documents for archiving, the at least one document management workstation being in communication with at least one of a copy, print, and facsimile operation (261, 265, 270), said system operatively disposed to:

Art Unit: 2625

collect electronic image data of each and every email document in a plurality of email documents transmitted over the network (270) in response to a single user input command, the electronic image data being a copy of each and every email document transmitted over the network (102, Fig.1);

cause said image data to be stored in the at least one database (340) to perform the unconscious capture archiving, wherein the at least one database further comprises image data from unconscious capture archiving of electronic document images from the at least one of a copy, print, and facsimile operation, wherein the aforementioned steps are carried out transparent to the user and without further input from the user notwithstanding the single user input command, and the aforementioned steps capture electronic document images of the plurality of email documents transferred over the network (103, Fig.1), (Figs.1-4; Abstract; col. 3, lines 1-60; col. 4, lines 3-13, lines 21-23, lines 56-63; col. 4, line 64 – col. 5, line 6; col. 5, lines 12-60; col. 6, lines 9-36; col. 8, lines 63-67; col. 9, lines 1-3).

Peairs et al does not directly teach that the computer system includes an email server. However, Fig.2 shows a system connecting to a client computer (210) and to other communication interfaces 264, 260, 270 connecting to printer 261, modem of a facsimile device 265 and network such as LAN, WAN, Internet, etc., which can transmit and receive emails. Peairs et al further teaches that the computer system comprises a paperless printer (PLP) 281 that is coupled to I/O port 280. PLP 281 may comprise a file server to store digital images of documents or I/O port 280 can be coupled to other peripheral device. It would have been obvious to one skilled in the art at the time the invention was made to modify the computer system in Peairs et al comprise an email server since the teaching in Peairs et al can be read on

Art Unit: 2625

the claimed invention while Peairs alternatively teaches a server for storing digital images of documents including emails.

Claims 22 and 29 are method claims of apparatus claims 20 and 25. Claims 22 and 29 are rejected for the same rationales set forth for claims 20 and 25.

Concerning claims 21, 23-24, 26-28, 30-32, Peairs et al further teaches the at least one of the copy, print, and facsimile operation comprises at least one of a copier operation, printer operation, and facsimile machine operation that archived image data for at least one of the copier operation, printer operation, and facsimile machine operation (col. 3, lines 7-12); causing the collected image data of every email to be stored comprises storing at least one of an origin address and destination address for an email (col. 5, lines 36-40; col. 5, line 62 – col. 6, line 8; col. 6, lines 21-31; col. 7, lines 8-11, lines 51-53); storing at least one of a date of transmission and time of transmission for an email (col. 7, line 61 – col. 8, line 16); the destination comprises a destination client system; the email document comprises an email document that was at least one of received and sent; at least one database is configured to store image data that was archived from at least one of a copier operation, a printer operation, and a facsimile machine operation (col. 3, lines 1-21; col. 5, lines 1-6, lines 33-49; col. 6, lines 21-31; col. 7, lines 8-11).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Hitchcock (US Patent No. 6,487,558) discloses a method for generating database server configuration documentation.

Art Unit: 2625

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Madeleine AV Nguyen
Primary Examiner
Art Unit 2625

July 12, 2007